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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,148	09/22/2003	Daniel A. Elefante	2603U.001	4558

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,148

Applicant(s)

ELEFANTE, DANIEL A.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040107</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 4 and 5 are objected to because of the following informalities: the claim discloses the enclosure is portable or stationary. The enclosure is an element of the overall apparatus, the kiosk. Therefore it is unclear if the enclosure is portable or stationary, or the entire kiosk is portable or stationary. If the enclosure is portable, does this mean the enclosure is removed from the kiosk? For examination purposes, the examiner is assuming, based on the specification, that the entire kiosk is portable or stationary, not just the enclosure.
2. Claim 6 is objected to because of the following informality: the word “therethrough” is not a word that is found in the dictionary. The examiner suggests separating the word into two words to form the phrase “there through”.
3. Claims 14-17 are objected to because of the following informalities: Claims 14-17 are dependent on Claim 13, which is a method by which passengers reduce the loss of prohibited items at a security check point, where a kiosk is provided, and used to collect the item for shipment. Claims 14-17 further comprise steps of providing the kiosk with specific features. The kiosk, which is working order, is already provided for use, therefore how can it further be provided with specific features, are these provided after use? These limitations are structure limitations and should be written as structure limitations, not as method limitations. The examiner considers Claims 14-17, to further define the structure of the kiosk, therefore the examiner suggest, modifying the claims, to state that the kiosk comprises..... instead of providing the kiosk with.... For example: Claim 14 states “providing said kiosk with a counter top” should be written as “said kiosk comprises a counter top”.

4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 13 recites the limitation "the financial transaction". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Segrest (US 2003/0191662).
10. With respect to Claim 13: A method for mailing back items at a security checkpoint (See abstract, and Figure 3) comprising the steps of:

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- a. Providing a kiosk adjacent to a security checkpoint, the kiosk equipped with devices facilitating shipment of the items (mail station, 20);
 - b. Using the devices to relate the item with the passenger (Steps 316 and 318);
 - c. Using the devices to identify the destination of the item (Step 320 and 328);
 - d. Completing a financial transaction for shipping the item (Step 314);
 - e. Preparing the item for shipment (Step 326);
 - f. Placing the item in the kiosk (Step 330);
 - g. Removing the items from the kiosk and facilitating delivery to the destination (Step 332).
11. With respect to Claim 18: The method further comprises the steps of:
- h. Providing a security checkpoint manned by security personnel, the security checkpoint having machines to search for prohibited items (300, the examiner considers this to be a security checkpoint, due to the fact that the passenger's baggage is checked, and the passenger is not permitted to proceed until the passenger as well as baggage is searched, see Paragraph 0037);
 - i. Detecting at least one prohibited item (Step 306);
 - j. Security personnel taking possession of the item (See Paragraph 0034);
 - k. Manning kiosk with personnel (See Paragraph 0035);
 - l. Security personnel delivering prohibited item to kiosk personnel (See Paragraph 0035);
 - m. Kiosk personnel taking possession of prohibited item for shipment (See Paragraph 0035).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liphard (US 2003/0226883), in view of Gil et al. (US 2002/0007281).

14. With respect to Claim 1: Liphard discloses the use of a kiosk (1) for use in association with a security checkpoint permitting deposit of prohibited items for shipment to a desired location (See abstract). The kiosk comprising an enclosure adapted to store packaging materials (Reference numeral 11) and labels providing instructions for shipment (Reference numeral 13); Liphard discloses the enclosure having a countertop (Reference numeral 4).

15. Liphard discloses a place for container depository (reference numeral 17) for the passage of items into the enclosure, however fails to disclose the depository being a tamper proof door hinged in said countertop and adapted to permit one-way passage of items into the enclosure. Gil discloses the use of a mailing machine with an automatic door (Paragraph 0072). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liphard, to include the secure door of Gil, in order to provide increased security for items being mailed (See Gil, Pages 6 and 7).

16. The combination of Liphard and Gil, discloses the outer door, but discloses the door is on rollers with pulleys and guides (See Paragraph 0072), and fails to expressly disclose the door is

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hinged to the counter top. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the door hinged as opposed to on rollers, because Applicant has not disclosed that hinging the door provides an advantage, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the door hinged or on the rollers/pulley system taught by Gil, because both create a secure door that prevents unauthorized users from accessing mail items. Therefore, it would have been an obvious matter of design choice to modify Liphard and Gil, to obtain the invention as specified in Claim 1.

17. With respect to Claim 3: Liphard also fails to disclose the enclosure includes a microphone connected to an audible recording device. Gil discloses the use of a microphone, in which a voice recognition system for receiving user input (Paragraph 0061), and discloses that the inputs are stored and can be retrieved (See Paragraph 0093), therefore it is the examiner's position that the input is stored, therefore the audible message is stored. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Liphard, to include the microphone, with the voice recognition input, in order to provide the ability of system or respond to a user's spoken command (See Gil Page 4).

18. With respect to Claim 4: the enclosure is portable (Liphard discloses the system being in the form of a credenza, and does not disclose it is connected or inserted into a wall, therefore the examiner considers this to be portable, Paragraph 0017).

19. With respect to Claim 5: the enclosure is stationary (Liphard discloses the invention can be housed in a wall, therefore the examiner considers this to be stationary, Paragraph 0017).

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20. With respect to Claim 6: the enclosure is connected to a shaft, adapted to pass items for shipment there through (see Figure 2c).

21. With respect to Claim 7: Gill discloses the tamper proof door is connected to a payment device, where operation of the payment device, releases the tamper proof door (See Paragraph 0071 and 0072).

22. With respect to Claims 8-10: Gil discloses the enclosure includes a safety depository, having reinforced walls, the counter top is reinforced and the tamper proof door accesses the interior of the safety depository (Reference 410, Figure 2b).

23. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) in view of Liphard (US 2003/0226883)

24. With respect to Claim 14: Segrest, as disclosed above for Claim 13, discloses the use of a method for mailing items back to a passenger, however fails to specifically disclose the specifics of the mailing center (20). Liphard discloses the use of a kiosk used at a security check point, which comprises:

- n. A counter top (4);
- o. A security depository (17);
- p. Providing the counter top with a tamper proof door opening into the depository (See Paragraphs 0025 and 0026).

25. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Segrest, to include the enclosure of Liphard, in order to provide a

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easy to use secure depository in a pre-screening area, so that a passenger does not have to leave personal items behind on their travels (See Liphard, Page 1).

26. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) in view of Gil et al. (US 2002/0007281)

27. With respect to Claim 15: Segrest discloses the use of a mailing system used with a security check point, but is silent as to the features of the mailing station. Gil discloses the use of a mailing center kiosk (100) comprising:

- q. A counter top (See Figure 1a, the examiner considers the top of the kiosk to be a counter top);
- r. A keyboard (See Paragraph 0061);
- s. Where a user inputs instructions to said computer by the keyboard facilitating shipment of the items (See Paragraph 0061).

28. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Segrest to have the mail station be the kiosk of Gil, in order to provide an automated mail processing system which dispenses postage and securely stores items for mailing (See Gil, abstract and Page 3)

29. With respect to Claim 17: Segrest fails to disclose the enclosure includes a microphone connected to an audible recording device. Gil discloses the use of a microphone, in which a voice recognition system for receiving user input (Paragraph 0061), and discloses that the inputs are stored and can be retrieved (See Paragraph 0093), therefore it is the examiner's position that the input is stored, therefore the audible message is stored. It would have been obvious to one

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having ordinary skill in the art at the time the invention was made, to modify Segrest, to include the microphone, with the voice recognition input, in order to provide the ability of system or respond to a user's spoken command (See Gil Page 4)

30. Claims 2, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liphard (US 2003/0226883) and Gil et al. (US 2002/0007281) as applied to claims 1 above, and further in view of Hansen (US 2002/0156645).

31. Liphard and Gil disclose an mailing enclosure for mailing items at a security checkpoint, however fails to disclose the use of a camera, to provide a view of the counter top, and connected to a visual recording device. Hansen, discloses the use of a locker system, which can accept packages, with comprises a camera (15) coupled to recorders, which capture and record images (See Paragraph 0035). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the enclosure of Liphard and Gil, with a camera and recording device, of Hansen, in order to determine if, or verify that an article has been placed into the kiosk. (See Hansen, Page 3).

32. With respect to Claim 11: Liphard discloses the use of the combination of a security check point (paragraphs 0003-0005) and a kiosk for mailing items not permitted to pass through the security check point (Paragraph 0008 and 0013).

33. Liphard discloses the use of a kiosk (1) for use in association with a security checkpoint permitting deposit of prohibited items for shipment to a desired location (See abstract). The kiosk comprising an enclosure adapted to store packaging materials (Reference numeral 11) and

labels providing instructions for shipment (Reference numeral 13); Liphard discloses the enclosure having a countertop (Reference numeral 4).

34. Liphard discloses a place for container depository (reference numeral 17) for the passage of items into the enclosure, however fails to disclose the depository being a tamper proof door hinged in said countertop and adapted to permit one-way passage of items into the enclosure. Gil discloses the use of a mailing machine with an automatic door (Paragraph 0072). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liphard, to include the secure door of Gil, in order to provide increased security for items being mailed (See Gil, Pages 6 and 7).

35. The combination of Liphard and Gil, discloses the outer door, but discloses the door is on rollers with pulleys and guides (See Paragraph 0072), and fails to expressly disclose the door is hinged to the counter top. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the door hinged as opposed to on rollers, because Applicant has not discloses that hinging the door provides an advantage, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the door hinged or on the rollers/pulley system taught by Gil, because both create a secure door that prevents unauthorized users from accessing mail items. Therefore, it would have been an obvious matter of design choice to modify Liphard and Gil, to obtain the invention as specified in Claim 1.

36. Liphard also fails to disclose the enclosure includes a microphone connected to an audible recording device. Gil discloses the use of a microphone, in which a voice recognition system for receiving user input (Paragraph 0061), and discloses that the inputs are stored and can

be retrieved (See Paragraph 0093), therefore it is the examiner's position that the input is stored, therefore the audible message is stored. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Liphard, to include the microphone, with the voice recognition input, in order to provide the ability of system or respond to a user's spoken command (See Gil Page 4).

37. While Liphard and Gil do not explicitly disclose that security checkpoint comprises an X-ray scanner, Official notice is taken that X-ray scanners used at security check points are old and well known. X-ray scanners have been used in airports for the scanning of baggage to see inside a passengers personal items, without having to open up the items/bags. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to provide an X-ray machine at the security check point of Liphard, in order to provide a quick non-invasive way to examine passengers' belongings.

38. Liphard and Gil disclose an mailing enclosure for mailing items at a security checkpoint, however fails to disclose the use of a camera, to provide a view of the counter top, and connected to a visual recording device. Hansen, discloses the use of a locker system, which can accept packages, with comprises a camera (15) coupled to recorders, which capture and record images (See Paragraph 0035). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the enclosure of Liphard and Gil, with a camera and recording device, of Hansen, in order to determine if, or verify that an article has been placed into the kiosk. (See Hansen, Page 3).

39. With respect to Claim 12: Gil discloses the enclosure includes a safety depository, having reinforced walls, the counter top is reinforced and the tamper proof door accesses the interior of the safety depository (Reference 410, Figure 2b).

40. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segrest (US 2003/0191662) as applied to claim 13 above, and further in view of Hansen (US 2002/0156645).

41. Segrest, as disclosed above, discloses a method for mailing items using a mailing station, or kiosk, however fails to disclose the station having a camera with a recording device, and visually recording the item and the passenger. Hansen, discloses the use of a locker system, which can accept packages, with comprises a camera (15) coupled to recorders, which capture and record images (See Paragraph 0035) of the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the mailing station of Segrest, with a camera and recording device of Hansen to record the user, in order to determine if, or verify that an article has been placed into the kiosk. (See Hansen, Page 3).

Conclusion

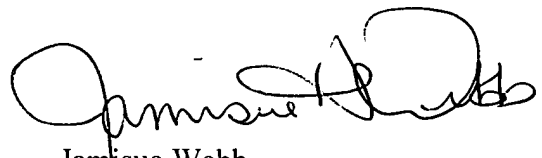
42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cinquini et al. (US 2004/0010430) discloses the use of a kiosk adjacent to a security check point for mailing items which are not permitted to pass through the check point, Foschi (5,570,290) discloses the use of a postal/franking machine and Check Point Mailers discloses the use of a kiosk to mail back an item at a security check point

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamisue Webb
Patent Examiner
Art Unit 3629